

## REMARKS

In the Office action dated October 4<sup>th</sup>, 2006, the Examiner acknowledged Applicant's election to restrict to claims 1 - 17. Applicant reserves the right to file a divisional for claims 18 - 20.

The Examiner requested a bracket around the elements in each of Figures 3, 4, 7 & 13. Included herewith are "Replacement Sheet" drawings with a bracket around the elements in each of the aforesaid Figures. The bracket placement is based upon Applicant's best judgement and can be easily moved pursuant to the Examiner's direction.

The Examiner rejected claims 1, 5, & 13 pursuant to 35 U.S.C. §102(b) as anticipated by *Winther*, U.S. # 2,947,564 and claims 1, 2, 5, 10 & 13 as anticipated by *Federico*, U.S. #5,630,243. The Examiner further rejected pursuant to 35 U.S.C. §103(a), claims 1 - 3, 5, 16, & 17 as obvious in light of *Thornton*, U.S. #6,272,716.

Claims 4, 6 - 9, 11, 12, 14 & 15 were objected to as being dependent upon a rejected base claim but were indicated allowable by the Examiner if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant has amended claims 1, 2, 10, 13, & 16 and believes the aforesaid together with the corresponding dependent claims comply with the requirements of 35 U.S.C. §102(b) & §103(a). Applicant respectfully traverses the Examiner's §102(b) and §103(a) rejections. Applicant further states that no new matter has been added to the present art Application and antecedent basis for all amendments are found within the specification.

Regarding the aforesaid §102(b) rejection of Applicant's amended claims 1, 5, & 13 including the corresponding dependent claims, *Winther* describes a mechanic's tool and not a toiletry device. (Col. 1, Line 15) *Winther* further describes two types shaft ends which only include grip fingers **6** (Col. 1, Line 61) and a ball and socket magnet **11** (Col. 2, Lines 2 - 3). Obviously, the magnet could not hold toilet paper. The fingers are at the end and could not hold a toilet paper roll placed around the threaded portion **7** end as Applicant does with his mandrel or base. Nowhere is mention made to a "jaw system" capable of holding toilet paper as in Applicant's Claims. Toilet paper is not even mentioned in *Winther* and even if *Winther* was attempted to be used for self wiping, a ball of toilet paper would have to be inserted into the fingers **6** and used at the end of the device rather than around it. This speculated use of *Winther* would be uncomfortable and of limited hygienic quality.

As aforesaid, *Winther* is also silent as to whether his device may hold one or more rolled pieces of toilet paper whereby a user may use said one or more pieces of toilet paper to wipe after toilet use. Based upon the Figures of *Winther*, it seems highly unlikely that the apparatus of *Winther* could be used for holding toilet paper and then wiping after toilet use. *Winther* does not suggest, make a motivation for, or explain a such a use. Applicant specifically limits use to such with the

unique form necessary to accomplish the claimed limitations.

Regarding the aforesaid §102(b) rejection of Applicant's amended claims 1, 2, 5, 10, & 13 including the corresponding dependent claims, *Federico* describes a toilet cleaning tool and not a self wiping toiletry aid. *Federico*'s art holds a cleaning pad for cleaning a toilet bowl. The jaws 7, 8 are specifically defined as a "rectangle" which could not be used for wiping. (Col. 4, Lines 17 - 20) No mention is made to a mandrel and an arm. The element of toilet paper rolled around a mandrel and useable for self wiping is missing. *Federico* is silent as to his shape for a particular use which is also an element of Applicant's claims. Applicant specifically states that his mandrel allows a roll of toilet paper to be placed there around and be used for wiping. This limits to a size, shape, and form which will fit and function properly. The whereby or utilization portion of Applicant's claims give form to the elements there preceding which represents a limitation on the scope of Applicant's claims. That is, it places a particular shape and form. A rectangular jaw is impractical to be used for self wiping without incurring serious hygienic and comfort issues.

Under 35 U.S.C. §102, anticipation requires that each and every element of the claimed invention be disclosed in the prior art. In addition, the prior art reference must be enabling, thus placing the allegedly disclosed matter in the possession of the public. *Akzo N.V. v. U.S. International Trade Commission*, 1 USPQ 2d 1241, 1245 (Fed. Cir. 1986), *cert. denied*, 482 U.S. 909 (1987). As aforesaid, *Winther & Federico* are silent about many of the claimed elements of Applicant's amended claims. *Winther & Federico* do not speak of placing toilet paper around an end and then holding it between a side or bottom with a retainer arm whereby the paper could be used for self wiping. The fingers 6 of *Winther* and the rectangular nature of *Federico* would most assuredly interfere with the wiping process, possibly cause minor irritation or injury, and force the user to use the very tip instead of the side of the end. The element of wiping after toilet use is not an analogous art to a mechanics tool which is used to pick up parts or a toilet cleaning device which is used to hold a pad for scrubbing.

Further relating to *Winther & Federico*, invalidity for anticipation requires that all of the elements and limitations of the claim are found within a single prior art reference. There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *Scripps Clinic & Research Foundation v. Genentech Inc.*, 18 USPQ 2d 1001, 1010 (Fed. Cir. 1991). The prior art references of *Winther & Federico* do not disclose the aforesaid unique features, functions, or results of Applicant. The aforesaid is further reinforced in *Motorola, Inc. v. Interdigital Tech. Corp.*, 43 USPQ 2d 1481, 1490 (Fed. Cir. 1997) as stated, "for a prior art reference to anticipate a claim, the reference must disclose each and every element of the claim with sufficient clarity to prove its existence in the prior art." *Motorola, Inc.* further states, "although this disclosure requirement presupposes the knowledge of one skilled in the art of the claimed invention, that presumed knowledge does not grant a license to read into the prior art reference teachings that are not there." As aforesaid, each and every unique afore described element of Applicant are not found in *Winther* or *Federico*, *Winther* and *Federico* are not hygienically functional as a toiletry device and not anticipated as such, and even if *Winther* or *Federico* could somehow be utilized as a toiletry wiping aid, they never disclosed the essential

element of how to roll, wipe, and discard or limit their shape to provide such.

Regarding the aforesaid §103(a) rejection of Applicant's claims 1 - 3, 5, 16, & 17 in light *Thornton*, Applicant incorporates by reference the aforesaid distinctions stated with respect to the §102(b) rejections. *Thornton* specifically teaches at Column 3, Lines 38 - 64 a pair of jaws **230, 300** within a rectangular cavity into which a piece of toilet paper is pinched. It is worth noting that nowhere does *Thornton* show or describe a roll of toilet paper around the gripping apparatus **200** end. With the embodiment of *Thornton*, it seems impossible to roll paper around the end and also grip with his embedded pair of jaws. In fact, a roll of paper could not be placed over the end of *Thornton* without prohibiting the jaws from opening. It is anticipated that *Thornton* would have a user place sheets and not rolls of paper directly into his jaws **230, 300** which would leave a significant portion of his end exposed during the wiping process. *Thornton* specifically states at Col. 4, Lines 57 - 58 that toilet paper can thus be inserted between the jaws with no mention of rolling around the jaws. Applicant's limitation of rolling around a mandrel will not work with the art of *Thornton* and is not motivated, suggested or taught therein. As with the §102(b) references, this is a less hygienic alternative to Applicant's art with a different form, different mode of functioning, and specifically different elements with different placement.

None of the references cited including *Thornton*, *Winther*, or *Federico* either individually or collectively, have all of the unique elements of Applicant's amended claims as presented herein, nor do they provide a motivation, suggestion, or teaching of the desirability of making the specific combination that was made by Applicant with the limitations claimed. Regarding the aforesaid §103(a) rejections, the Federal Circuit now uses the suggestion test to assess obviousness rejections. In the case of *In re Kotzab*, 55 USPQ2d 1313 (Fed. Cir. 2000), the Federal Circuit stated that "to establish obviousness based on a combination of elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the **specific** combination that was made by the applicant." (the term "*specific*" is emphasized) The cited references do not provide a motivation, suggestion, or teaching of the desirability of providing a retaining arm on a bottom side of a mandrel which allows a roll of toilet paper to be placed over the mandrel and held and which is capable of use for self wiping. As stated in *Ruiz v. A.B. Chance Company*, 357 F.3d 1270, 69 USPQ2d 1686, 1690 (Fed. Cir. 2004), "in making the assessment of differences, section 103 specifically requires consideration of the claimed invention "as a whole." Inventions typically are new combinations of existing principles or features. . . . The "as a whole" instruction in title 35 prevents evaluation of the invention part by part." The cited references do not place the unique combination of elements together or specify a shape or form limitation which allows self wiping. The aforesaid is further reinforced in *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 56 USPQ 2d 1456, 1459 (Fed. Cir. 2000) citing *C.R. Bard, Inc. v. M3 Sys. Inc.*, 157 F.3d 1340, 1352, 48 USPQ 2d 1225, 1232 (Fed. Cir. 1998) which states as relating to obviousness, "the first requirement is that a showing of a suggestion, teaching, or motivation to combine the prior art references is an "essential evidentiary component of an obviousness holding."".

The aforesaid motivating suggestion must also be explicit. *Winner International Royalty Corp. v. Wang* 48 USPQ2d 1139, (D.C.D.C. 1998). The fact that prior art "may be modified in the

manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” *In re Fritch*, 922 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992). Again, as aforesaid and without suggestion by the Examiner, *Thornton*, *Winther*, or *Federico* do not provide a motivation, suggestion, or teaching of the desirability of Applicant’s art as described in the amended claims with the geometric or functional attributes described. That is, the aforesaid are bereft of suggestion as to how a roll of paper may be placed around a mandrel, held whereby the roll covers a substantial portion of the mandrel and used in a self wiping application.

Applicant herewith includes and incorporates by reference a 37 CFR § 1.132 declaration to show a long felt but unfulfilled need in the marketplace in an effort to overcome obviousness rejections under 35 U.S.C. 103. The declaration speaks for itself; elaboration of its factual content is not required here. The Federal Circuit has spoken on the use of said declarations to overcome obviousness determinations in *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 7 USPQ 2d 1222, 1226–27 (Fed. Cir.), cert. denied, 488 U.S. 956 (1988). To overcome an obviousness determination, the Applicant must establish a nexus between the product claimed and commercial success. The Court noted that a “prima facie case of nexus is generally made out when the patentee shows both that there is commercial success, and that the thing (product or method) that is commercially successful is the invention disclosed and claimed in the patent.” The Court further noted that:

“A patentee is not required to prove as part of its prima facie case that the commercial success of the patented invention is not due to factors other than the patented invention. It is sufficient to show that the commercial success was of the patented invention itself. A requirement for proof of the negative of all imaginable contributing factors would be unfairly burdensome, and contrary to the ordinary rules of evidence.”

Applicant maintains that if the claimed device were obvious to one skilled in the art, other competitors would have prevented Applicant’s claimed apparatus from finding commercial success and that Applicant’s sales of the claimed product and method would not have enjoyed the commercial success which has occurred since its introduction to the market. As stated, Applicant need only show commercial success was of the patented invention itself; this is shown in the declaration of Applicant.

In view of the foregoing, the independent claims along with their corresponding dependent claims are herewith submitted as patentable. Accordingly, favorable reconsideration and allowance of this application is requested.

Respectfully submitted,



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**CERTIFICATE OF MAILING**

I certify that the foregoing **AMENDMENT A** is being deposited with the United States Postal Service as First Class Mail, postage prepaid, in an envelope addressed to: Commissioner of Patents, Mail Stop Fee Amendment, P.O. Box 1450, Alexandria, VA 22313-1450, on December 21, 2006.



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Kevin L. Klug